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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,744

02/03/2005

Martin M. Browne

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11/04/2009

GE HEALTHCARE, INC.

IP DEPARTMENT 101 CARNEGIE CENTER

PRINCETON, NJ 08540-6231

EXAMINER

STIGELL, THEODORE J

ART UNIT

PAPER NUMBER

3763

MAIL DATE

DELIVERY MODE

11/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,744	Applicant(s) BROWNE, MARTIN M.	
	Examiner THEODORE J. STIGELL	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 17, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 3, 5, 15 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/8/2009 has been entered.

Claim Objections

Claims 3, 5, and 17 are objected to because of the following informalities: There is already antecedent basis for "a hand-held syringe". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The 35 USC 112 rejection of claim 20 has been withdrawn in light of the amendments filed on 7/8/2009.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14, 16-17, and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Reilly et al. (6,821,013). Reilly discloses an adapter (100) connectable with an automatic syringe pump (10) and a hand-held syringe (20), the syringe including an elongate syringe body containing contents to be dispensed, wherein the adapter comprises a syringe driver (200, 210, 220) for rotating the syringe body. The examiner maintains that element (10) can be considered an automatic syringe pump and that element (20) can be considered a hand-held syringe since it is a syringe and can be hand-held. Furthermore, these elements are only functionally claimed in independent claim 1 and therefore are not given much patentable weight in regards to this claim.

Reilly further discloses that the adapter comprises an adapter body receivable by a syringe receiving unit (60), a syringe retainer (160) in the form of a ring for retaining at least one flange (22a) of the syringe, wherein the syringe driver further comprises a motor (200) and a drive belt (220) for urging the syringe ring to rotate, wherein the adapter comprises a portion that is capable of being recognized by a size reading unit, further comprising a syringe holding arm (inner surface of 160), a guide piston (140), an extension arm (narrowed distal end of 140), and a dispense rod (146) supported by the extension arm. The examiner maintains that the inherent use of the device of Reilly meets the limitations of claim 20.

Claims 1-10 and 16-17, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schneider et al. (US 2002/0077588). Claim 1 is being interpreted as

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positively claiming an adapter comprising a syringe driver, wherein the syringe driver is capable of rotating the syringe body. The examiner notes that the limitation of "connectable" with a syringe pump and syringe is a functional limitation which the reference only has to have the capability of performing. The examiner is interpreting "connectable" as the ability of two elements to come into contact with each other. Therefore, the functional limitations are not being given much patentable weight. The examiner also notes that the positively recited limitation of a syringe driver is broad too. The term "syringe driver" by itself does not denote any specific structural limitation and therefore the examiner maintains that any structure that can rotate a syringe body can be interpreted as a "syringe driver".

In regards to claim 1-10 and 16-17, Schneider discloses an adapter (24, 30b, 30a) that is connectable with a syringe pump and a syringe (22), the adapter comprising a syringe driver (24, 30b) for rotating the syringe body, the adapter comprising an adapter body (24, 30b, 30a) that is capable of being received by a syringe receiving unit of a syringe pump, further comprising a syringe retainer (30a) comprising an annular flange that is capable of engaging a flange of a syringe, wherein the syringe driver further comprises a motor (25) and drive means (31) for rotating the syringe body, wherein (30b) can be considered a belt, wherein the adapter is capable of being recognized by a size-reading unit, wherein the retainer is offset from the adapter body, and wherein the adapter can be arranged parallel to the syringe.

Allowable Subject Matter

Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 7/8/2009 have been fully considered but they are not persuasive.

In response to the applicant's argument that Reilley et al. (US 6,821,013) does not qualify as prior art, the examiner respectfully disagrees. The applicant argues that Reilly has a priority date of December 20, 2002 but the examiner notes that this is incorrect. Reilly has a priority date of December 11, 2001 which is the date of the provisional application in which all of the subject matter of 6,821,013 is disclosed. The examiner maintains that Reilly anticipates the claimed limitations.

In response to the applicant's argument that Schneider does not disclose the limitations recited in claim 1, the examiner respectfully disagrees. The examiner maintains that elements (24, 30a, 30b) can be considered an adapter. The adapter is capable of being connected to a syringe (22) and a syringe pump (the simple act of placing the defined adaptor and a syringe pump in contact with each other meets the limitation of connectable).

The applicant is invited to contact the examiner to discuss possible claim amendments.

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THEODORE J. STIGELL whose telephone number is (571)272-8759. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Theodore J Stigell/
Examiner, Art Unit 3763

/Nicholas D Lucchesi/
Supervisory Patent Examiner, Art Unit 3763